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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,107	06/02/2000	Masahiro Oashi	NAK1-AS70r	6813

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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/27/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

22

# Office Action Summary

Application No.

09/587,107

Applicant(s)

OASHI ET AL.

Examiner

Stephen S. Hong

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/3/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This office action is responsive to the amendments filed on November 17, 2003 and April 20, 2004, IDS filed on June 24, 2003, and supplemental Declaration filed on April 30, 2004.

2. The previous objection to the reissue oath/declaration filed with this application for being defective (see 37 CFR 1.175 and MPEP § 1414) has been withdrawn.

The oath/declaration had been objected to for identifying an "error" that Applicant seeks to "correct", which was allegedly found to be deficient under 35 USC 112, first paragraph. The Declaration filed on April 30, 2004 lists the following errors upon which the reissue is based, and the Office accepts them as the proper errors for the reissue:

"Claims 1, 4, 7, 25 and 26 define page information as 'successively' stored in a storage area, while the prior art did not require such a description and therefore the patentees claimed less than they had a right to claim."

"Claims 19 defines 'successively' regarding time sequence information in a storage area, while the prior art did not require such a description and therefore the patentees claimed less than they had a right to claim.", and

"Claim 7 is amended to replace 'disc' with --recording medium--. "

However, the reissue declaration filed on April 30, 2004 is defective, since the declaration is not signed by the inventors. Applicant can do one of the followings to correct the declaration.: (1) Re-summit the reissue declaration filed on April 30, 2004 that includes the signatures of all inventors, or (2) Summit *Supplemental Declaration for*

*Reissue Patent Application to Correct "Errors" Statement* under 37 CFR 1.175 using a PTO Form "PTO/SB/51S" (downloadable at the USPTO website) which is signed by all inventors.

Accordingly, the rejection of claims 1-26 as being based upon a defective reissue Declaration under 35 U.S.C. 251 is maintained.

***Allowable Subject Matter***

3. The following is an examiner's statement of reasons for allowance:

The rejection of claims 1-9, 19-21, and 25-26 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement has been withdrawn in view of Examiner's reconsideration. The claim(s) were rejected for allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In the previous Office Action (mailed on June 18, 2003), Examiner explained that claims 1-9, 19-21, and 25-26 are directed to embodiments 1 or 2 in the Applicant's specification. In each of embodiments 1 and 2, the specification explicitly states the advantage that "successiveness" provides. Neither of embodiments 1 or 2 is described with respect to "non-successive" storage. Thus, for the embodiments, the specification only provides support for information that is stored "successively". For this reason, the

removal of “successively” from the claims was rejected under 35 U.S.C. 112, first paragraph as removing an essential functional element.

Upon further consideration, however, the rejection under 35 U.S.C. 112, first paragraph is withdrawn. Previously, each of the claim(s) were rejected for “containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. “ Claim 1, for example, claims the feature of “... pieces of page information .... [successively] stored in a storage area. (“successively” in the bracket now removed in claim 1)” The rejection was based on the amendment that removed the word “successively” in the limitation. However, the test under 35 U.S.C. 112, first paragraph, should have been whether or not the specification describes in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention the feature of “pieces of page information being stored in a storage area.” Clearly, the specification does describe the feature of “pieces of page information being stored in a storage area.”

Specifically, with respect to embodiment 1, on which claims 1-5 and 25-26 are based, refer to column 8 (lines 25 et seq): *Storage areas 401, 402, and 403 of the CD-ROM 201 continues successively on the track, and data stored in each of the storage areas is read one after another as the CD-ROM 201 turns.* Figure 4 shows “successive” storage (physically adjacent storage areas—conventional storage technique for CD-ROM). At column 17 (lines 16-41): *The contents of each page stream and each time line stream is successively stored on the same track of the CD-ROM, so head seek*

*does not happen when the information is successively read. Speed of data readout from the same page stream and the same time line stream is fast and breaks in the sound and dynamic pictures do not happen, so that multimedia information is played back accurately. At column 17 (lines 39-41): . . . the load of the CPU is decreased, unlike the case in which the information are recorded in the different storage areas in the recording medium. At column 18 (lines 10-15): As the contents of the time line stream is successively stored on the same track, seek of a read head does not happen, even if the designated still picture data and audio data are loaded from the CD-ROM 201 at each display time. This enables displaying of dynamic pictures without breaks in sound and images.*

With respect to embodiment 2, on which claims 7-9 and 19-21 are based, refer to column 19 (lines 1-6: *As shown in figure 13, elements of the hardware construction of the multimedia record device 1200 is almost the same as the multimedia information playback device 200 shown in figure 3, except that the multi-media information record device 1200 does not comprise the joy pad 306 but comprises a hard disc 1310. At column 21 (line 62) through column 22 (line 18): In step 1402, when the contents to be described do not exist in the page stream, the stream creation 1202 requests the input instructing order of recording the page stream and the time line stream successively onto the storage areas of the track of the CD-ROM 1210 (Step 1429). The stream creation unit 1202 posts the recording order to the CD-ROM write unit 1209. The CD-ROM write unit 1209 reads the page stream and the time line stream from the page stream storage unit 1207 the time line stream storage unit 1208, respectively, and*

*stores them in the CD-ROM 1210 (Step 1430). At column 22 (lines 12-15): Also, each page stream and time line stream can be stored successively in the storage areas on the same track of the CD-ROM 1210.*

Thus, the specification clearly describes the claimed subject matter of “pieces of page information being stored in a storage area” which in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention out that the claimed feature by explaining that the embodiment 1 and 2 use the “successive” storage technique, which is clearly a form of a storage technique. Therefore, the rejections under 35 USC 112, first paragraph, have been withdrawn.

4. As pointed out on page 7 of the previous Office Action (mailed on June 18, 2003; Paper #17), Applicant's arguments have overcome the rejection of the claims with respect to impermissible recapture. The Examiner agrees that “successively” was never an issue with respect to overcoming the prior art rejection in the prosecution of the parent case (08/512,302).

On page 34 of Amendment A of 08/512,302 (paper #6, filed 8/28/97), Applicant explicitly emphasized “pieces of page information” and “a plurality of images”—not “successively”. Furthermore, it is noted that the Applicant's argument in the last paragraph of page 34 of Amendment A mentions the term “successive.” However, the argument appears to be a general argument that reiterates the features of the claimed limitations. Since “successively” was not included in all of the sets of claims, and all of

the claims were allowed for the same reason (see Examiner's Amendment, paper #7, mailed 11/26/97), the impermissible recapture does not apply to the claims of this Reissue application.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Stephen Hong  
Primary Examiner  
Art Unit 2178  
August 25, 2004